



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,207	09/22/2003	Masanori Watanuki	04329.3141	5742

22852 7590 02/14/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

CASIANO, ANGEL L

ART UNIT PAPER NUMBER

2182

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/665,207	Applicant(s) WATANUKI, MASANORI	
	Examiner Angel L. Casiano	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/22/03; 5/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- The present Office action is in response to application dated 22 September 2003.
- Claims 1-14 are pending. All claims have been examined.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on 09/22/2003, 05/19/2004, and 05/24/2005 were filed after the mailing date of the application on 22 September 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 5, 8-9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Shu et al. [US 2002/0110073 A1].

Regarding claim 1, Shu et al. teaches a playback unit (see Abstract, "DVD player") which plays back predetermined information (see Id., "accessed by a single DVD player with a card reader"); an accommodation unit which accommodates a detachable recording medium (see "card reader 3", Figure 1); and a controller (see Page 1, 0014) which causes the playback unit to access to the recording medium accommodated in the

Art Unit: 2182

accommodation unit according to a first communication standard (see Page 1, 0014; "PCMCIA card") and causes an external apparatus to access to the recording medium according to a second communication standard (see Id. "ATA") different from the first communication standard.

As for claim 2, Shu et al. teaches the first communication standard as the PCMCIA and the second standard as the ATA (see Page 1, 0014).

As for claim 5, Shu et al. teaches the playback apparatus accessing the recording medium accommodated in the accommodation unit according to the first communication standard through a PCMCIA slot (see Page 1, 0014; "PCMCIA card").

Regarding independent claim 8, this corresponds to the access method of a playback apparatus comprising a playback unit which plays back predetermined information. This method is directed to the apparatus disclosed in claim 1. Shu et al. teaches the limitations corresponding to the apparatus and therefore also teaches the limitations corresponding to the method directed to the apparatus. Therefore, the present claim is rejected under the same basis.

Art Unit: 2182

As for dependent claims 9 and 12, these correspond to the access method of a playback apparatus comprising a playback unit which plays back predetermined information. Shu et al. teaches the limitations corresponding to the apparatus (as recited in claims 2 and 5) and therefore also teaches the limitations corresponding to the method directed to the apparatus. Therefore, the present claims are rejected under the same basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 2182

3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 3, 6-7, 10, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. [US 2002/0110073 A1] in view of Liu et al. [US 2003/0172209 A1].

As for claim 3, Shu et al. teaches a switch interposed between the playback unit and the accommodation unit (see Page 1, 0019). However, the reference fails to teach a "first switch element interposed between a terminal which receives a signal from the external apparatus and the accommodation unit and a second switch element interposed between the playback unit and accommodation unit, wherein when the playback unit accesses to the recording medium accommodated in the accommodation unit, the controller turns off the first switch element and turns on the second switch element, and when the external apparatus accesses to the recording medium, the controller turns on the first switch element and turns off the second switch element", as claimed.

As for these limitations, Liu et al. teaches a playback apparatus in which when the playback unit accesses the recording medium, a controller turns off communication between a terminal

Art Unit: 2182

and the accommodation unit (see Page 1, 0015; "when a card is inserted... the arbitration switch will switch..."). When an external apparatus accesses the recording medium, a controller turns off communication between the playback unit and the accommodation unit, according to Liu et al (see Page 1, 0015; "when the USB transfer interface is connected... implement data exchange between the CF card and the computer").

At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to obtain a playback apparatus ("player") capable of supporting various flash memory cards (see "MS/SD/MMC/SM") and plug-and-play interface, as taught by Liu et al. (see Page 1, 0002).

As for claim 6, Shu et al. does not teach accessing a recording medium through a USB terminal. As for this limitation, Liu et al. teaches accessing a recording medium via a USA interface (see Page 3, claim 3). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated above.

As for claim 7, while Shu et al. teaches a playback unit that plays back an audio file (see Abstract, "audio and video data"), it does not teach accessing a recording medium through a USB terminal. As for this limitation, Liu et al. teaches accessing a recording medium via a USA interface (see Page 3, claim 3) as well as playing back an audio file (see Abstract, "video/audio media player"). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated above.

As for dependent claims 10 and 13-14, these correspond to the access method of a playback apparatus comprising a playback unit which plays back predetermined information. The combination of references teaches the limitations corresponding to the apparatus (as recited in claims 3 and 6-7) and therefore also teaches the limitations corresponding to the method directed to the apparatus. Therefore, the present claims are rejected under the same rationale.

9. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. [US 2002/0110073 A1] in view of Oya [JP 2002007003 A]

As for claim 4, Shu et al. does not teach the playback apparatus as having a USB-ATA bridge which receives a USB standard signal from an external apparatus and converts the USB signal into an ATA signal and supplying the standard signal to the recording medium, as claimed.

As per these limitations, Oya teaches a converting part for converting between USB and ATA (see Figure4, "38"). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the references in order to utilize "plug-and-play functions" and a "hot plug function" which "are the excellent point of a USB standard", as explicitly taught by Oya (see Abstract).

As for dependent claim 11, this corresponds to the access method of a playback apparatus comprising a playback unit which plays back predetermined information. The combination of references teaches the limitations corresponding to the apparatus (as recited in claims 4) and therefore also teaches the limitations corresponding to the method directed to the

Art Unit: 2182

apparatus. Therefore, the present claim is rejected under the same rationale.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Piau et al. [US 2003/0067814 A1] teaches apparatus and architecture for a compact flash memory controller. Furthermore, the reference teaches that, "the microcontroller 216 is capable of retrieving data that is stored in the flash memory 222 in the usual manner and, instead of outputting this data the PCMCIA-ATA interface 204, the microcontroller 216 can route this data to a multi-function interface that outputs the data on an output bus that is configured for either serial I/O, parallel I/O" (see Paragraph 24).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 571-272-4142. The examiner can normally be reached on 9:00-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the


Art Unit: 2182

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alc

31 January 2006



KIM HUYNH
SUPERVISORY PATENT EXAMINER
2/2/06